

Attorney's Docket: 2000FR303
Serial No.: 09/821.876
Art Unit 1711

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REMARKS

Applicant notes that the rejection to claims 7, 8 and 11-16 under 35 USC § 112, second paragraph as being indefinite has been withdrawn.

Applicant notes that the rejection to claims 15 and 16 under 35 USC § 101 for reciting use without any steps has been withdrawn.

Applicant notes that in Applicant's Amendment filed on 1-29-2003 erroneously included the phrase to Amend the Specification, Applicant did not intend to amend the specification. Applicant respectfully requests that this objection to the application be withdrawn.

Claims 1-16 stand rejected under 35 USC § 103(a) as being obvious from Jacquinet '912 in view of Swofford '828. Applicants traverse this rejection. The motivation to modify the prior art must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. See *In re Napier*, 55 F. 3d 610, 613, 34 USPQ 2d 1782, 1784 (Fed. Cir. 1995) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination."); accord *In re Geiger*, 815 F. 2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1399 (Fed. Cir. 1989) ("[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification") (quoting *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). The Office argues that Swofford discloses a multifunctional

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acrylate. However the Office ignores that Swofford in column 7 discloses that up to 35 weight percent, preferably 15 to 25 weight percent, based on the total weight of the aqueous dispersion, of lower alkanol may be added to enhance stability. Jacquinet '912 teaches very low solvent water and solvent content. One of ordinary skill would not assume that a multifunctional acrylate that works in a system that employs up to 35 weight percent volatile organic solvent would work in Jacquinet '912 system of very low solvent and water content. Applicants respectfully request that the rejections under 35 USC § 103(a) be withdrawn and the claims allowed.

Claims 1-16 stand rejected under 35 USC § 103(a) as being obvious from Jacquinet '912 in view of Swofford '828. Applicants traverse this rejection. Applicant notes that the Examiner has stated that the rejection under 35 USC § 103(a) as being obvious from Jacquinet '912 may be removed upon a submission of a declaration under 37 CFR § 1.130 together with a terminal disclaimer in accordance with 37 CFR § 1.321(c). Applicant filed a terminal disclaimer under 37 CFR § 1.321 on January 29, 2003 and attached to this response is a declaration under 37 CFR § 1.130. Along with the declaration under 37 CFR § 1.130 Applicant has also supplied a Statement under 37 CFR § 3.73(b). Applicant respectfully requests the removal of the objection under 35 USC § 103(a) and respectfully requests allowance of claims 1-16.

Claims 1-16 originally stood rejected under the judicially created doctrine of obviousness type double patenting as being obvious from Jacquinet '912 in view of Swofford '828. Applicants as the common owner of Jacquinet '912, attached a terminal disclaimer with Jacquinet '912, in the prior amendment. As this objection was not repeated in the current Official action Applicant expects that the objection has been withdrawn.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is

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required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

Reconsideration and allowance of this application is respectfully requested.

Respectfully submitted,



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Attachment: Declaration under 37 CFR § 1.130
Statement under 37 CFR § 3.73(b)

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MAY 15 2003
GROUP 1700**